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09/934,093	08/21/2001	Daniel Burnstein	BU23	7163

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Daniel Burnstein  
35 Garden Road  
Brookline, MA 02445

EXAMINER
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RAYYAN, SUSAN F

ART UNIT	PAPER NUMBER
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2167

DATE MAILED: 03/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/934,093

Applicant(s)

BURNSTEIN ET AL.

Examiner

Susan F. Rayyan

Art Unit

2167

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 August 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. An examination of this application reveals that applicant is unfamiliar with patent prosecution procedure. While an inventor may prosecute the application, lack of skill in this field usually acts as a liability in affording the maximum protection for the invention disclosed. Applicant is advised to secure the services of a registered patent attorney or agent to prosecute the application, since the value of a patent is largely dependent upon skilled preparation and prosecution. The Office cannot aid in selecting an attorney or agent. Applicant is advised of the availability of the publication "Attorneys and Agents Registered to Practice Before the U.S. Patent and Trademark Office." This publication is for sale by the Superintendent of Documents, U.S. Government Printing Office, Washington, D.C. 20402.
2. Applicant is encouraged to contact the Examiner with any questions before filing the response.
3. Applicant has filed a new application on November 28, 2001.
4. Applicant has amended and canceled claims 25-26 without filing a preliminary amendment.
5. Regarding the cancellation of claims 25-26 in the newly filed application the Examiner considers them as canceled claims.
6. Claims 1-24 are pending, claims 25-26 are canceled.

***Specification***

7. Regarding the filing of a substitute specification:

The substitute specification filed November 28, 2001 has not been entered because it does not conform to 37 CFR 1.125(b) and (c) because: the statement as to lack of new matter under 37 CFR 1.125(b) is missing.

8. A substitute specification including the claims and drawings are required pursuant to 37 CFR 1.125(a) because Transmittal Letter, title page and specification on same page, abstract and figures on the same sheet. Transmittal sheet, Title sheet ,Specification, Abstract, Drawings, and Figures must each start on separate a sheet. See Arrangement of Specification below.

A substitute specification must not contain new matter. The substitute specification must be submitted with markings showing all the changes relative to the immediate prior version of the specification of record. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived. An accompanying clean version (without markings) and a statement that the substitute specification contains no new matter must also be supplied. Numbering the paragraphs of the specification of record is not considered a change that must be shown.

9. The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

#### **Arrangement of the Specification**

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC (See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text are permitted to be submitted on compact discs.) or  
REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.)
- (e) BACKGROUND OF THE INVENTION.
  - (1) Field of the Invention.
  - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (f) BRIEF SUMMARY OF THE INVENTION.
- (g) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (h) DETAILED DESCRIPTION OF THE INVENTION.
- (i) CLAIM OR CLAIMS (commencing on a separate sheet).
- (j) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (k) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

#### ***Drawings***

10. The drawings are objected to because figure 10 continues on to a second page, the figure should be contained within a single drawing sheet. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all

of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Objections***

11. Claim 3 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The claim does not further limit independent claim 1 it simply explains steps d) – g). (suggestion: The method of claim 1, further comprising the steps of ordering matches and sorting...")

12. Claims 1,4-15,17-21,24 are objected to because of the following informalities: Each claim must begin with a capital letter and end with a period. Periods must not be used elsewhere in the claims except for abbreviations. See MPEP section 608.01(m). Appropriate correction is required.

13. Claim 4-14, 16-22,24 are objected to because of the following informalities: for example: claim 4, "the method of forming communities", claim 4 depends from a method for automatic formulation of electronic communities. The following would be acceptable correction to the claim:

The method according to claim 1 further comprising the step of

Note the format of the claims in the patent(s) cited. Appropriate correction is required.

14. Claim 1 is objected to because of the following informalities:

(g) "causing said community will initially", (unclear);

(i) "shown above", (not necessary, this phrase should be removed);

(i) "same manner", (indefinite as to what is the same manner);

(i) "d)-g)", (suggest, as the steps of d)-g);

(k) "using this invention", (not necessary, this phrase should be removed);

(k) "the creation", (suggest using "creating").

15. Claim 19 is objected to because of the following informalities:

"(e.g." and "ect." (Claims begin with a capital letter and end with a period, no periods between). Appropriate correction is required.

16. Claim 24 is objected to because of the following informalities: "post same".

17. Claims 18,22 are objected to because of the following informalities: Examiner interprets the claim to depend from claim1. Applicant is requested to correct dependency.

**Claim Rejections - 35 USC § 112**

18. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

19. **Claims 9,11-12, 23-24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.**

Regarding claim 9, Examiner did not find reference to the limitation “sounds-like program”.

Regarding claims 11-12, Examiner did not find reference to the limitation “neural net”.

Regarding claim 23, Examiner did not find reference to the limitation “means to permit language translation...”

Regarding claim 24, Examiner did not find reference to the limitation “conduct joint searches ....rate jointly and severely ...”

**Claim Rejections - 35 USC § 102**

20. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.



**21. Claims 1-8,10,13-20,24 are rejected under 35 U.S.C. 102(e) as being anticipated by Emens et al (US 6,745,178).**

As per independent claim 1 Emens anticipates:

A method for automatic formation of electronic communities at summary;

a) providing a database for unique user identifier and associated search strings at col.5, lines 25-35;

b) entering a first unique identifier for a first user and a first associated search string into said database at col.7, lines 34-41;

c) determining whether said first search string substantially matches a search string previously stored in said database at col.5, lines 35-40;

d) querying said first user whether said first user wants to join a community in response to a matching search string at col.8, lines 26-36;

e) querying second user associated with said matching search string whether said second user wants to join a community with said first user at col.10, lines 1-5;

f) forming a community if said first user and said second user both respond affirmatively to community formation at col.8, lines 64-65 and col.10, lines 1-15;

g) said community will initially be anonymous--without specific identifying information until both parties agree to identify themselves to the other at col.10, lines 5-26;

h) displaying matches according to user preference to have matches sorted by date, closeness of search term, volume of similar searches, or a combination of some or all of these variables at col.8, lines 27-29 and col.9, lines 25-28;

- i) contacting these additional matches will be accomplished in the same manner as d)-g) shown above at col. 10, lines 1-4;
- j) creating "MySearch" pages with the results of various searching and matching shown at col.9, lines 20-27;
- k) the creation of certain organizational Searching and Matching pages to collect with permission the results of various searches and matching using this invention and making same available with appropriate levels of security at col.7, lines 7-19, 34-37.

Emens teaches providing a database for unique user identifier and associated search strings, entering a first unique identifier for a first user and a first associated search string into said database, determining whether said first search string substantially matches a search string previously stored in said database; d) querying said first user whether said first user wants to join a community in response to a matching search string, querying second user associated with said matching search string whether said second user wants to join a community with said first user, and forming a community if said first user and said second user both respond affirmatively to community formation, said community will initially be anonymous--without specific identifying information until both parties agree to identify themselves to the other, displaying matches according to user preference to have matches sorted by date, closeness of search term, volume of similar searches, or a combination of some or all of these variables, contacting these additional matches will be accomplished in the same manner as d)-g) , creating "MySearch" pages with the results of various searching and matching shown, as well as the creation of certain organizational Searching and Matching pages to collect with permission the results of various searches and matching using

this invention and making same available with appropriate levels of security at col.5, lines 36-40, col.7, lines 34-42, col. 8, lines 1-15, 26-30, 64-67, col. 9, lines 20-27 and col. 10, lines 1-40.

As per claim 2 same as claim arguments above and Emens anticipates:  
further comprises the step establishing a connection between said first user and said second user over the Internet at col.10, lines 1-2.

As per claim 3 same as claim arguments above and Emens anticipates:  
ordering matches and sorting them by virtue of date, volume, or closeness of the search term at col.5, lines 35-40, similarities of queries.

As per claim 4 same as claim arguments above and Emens anticipates:  
two or more persons over a telephone wireless or landline system, the Internet, a computer network, or a standalone computer at col10, lines 1-26.

As per claim 5 same as claim arguments above and Emens anticipates:  
also includes both new and previously created communities formed during a match on a standalone computer, networked computer or telephone system at col.7, lines 60-64 and col.10, lines 1-5, user joins existing chat or application invites user to start new chat.

As per claim 6 same as claim arguments above and Emens anticipates:  
the creation of a new community referenced in claim 1 if one or more relevant community(ies) already exist(s), wherein only the present user is asked to join an existing community at col.8, lines 26-30.

As per claim 7 same as claim arguments above and Emens anticipates:  
that can be determined using string matching at col. 11, lines 10-30.

As per claim 8 same as claim arguments above and Emens anticipates:  
method of determining the similarity of searches in claim 1 using external contextual  
identifiers at col.5, lines 35-40, answer set.

As per claim 10 same as claim arguments above and Emens anticipates:  
the method of determining the similarity of searches in claim 1 that is determined using  
natural language processing in which the underlying meaning of the word or phrase is  
matched against the underlying meaning of the words or phrase of prior searches at col.11,  
lines 14-15, natural language.

As per claim 13 same as claim arguments above and Emens anticipates:  
The method of applying in claim 1 a system of security permissions where similarity of  
searches is constrained by users or an administrator or employer or supervisor with a system  
of security permissions controlled automatically or by the intervention of an actual person  
granting security based upon any criteria at col. 6, lines 1-6, user may activate a share button.

As per claim 14 same as claim arguments above and Emens anticipates:  
The method of inputting and outputting of claim 1 where said method of input of the search  
terms and output communications can be via: a) the spoken word into a phone, b)email, c)

fax or d) web email, e) a network, f) automated software agents, g) instant messaging, h) SMS messaging, i) automated agents at col. 5, lines 14-15.

As per claim 15 same as claim arguments above and Emens anticipates:

The method of claim 1 wherein the search is performed on a stand alone computer or other communications device to: a) telephone communications network, b) an intranet, c) an extranet, d) the Internet at col. 5, lines 24-34.

As per claim 16 same as claim arguments above and Emens anticipates:

The method of providing in claim 1 to provide users with control over being notified of a match; and giving users the ability to turn such notification on and off, or to permit only recognized lists of users to be matched at col. 5, lines 57-60, user chooses to make query /results public or not public.

As per claim 17 same as claim arguments above and Emens anticipates:

The method of identifying in claim 1 an identifying string for the user's password and his or her: a) email address, b) fax number, c) identifier from a redirector source, d) telephone number at col. 7, lines 7-19.

As per claim 18 same as claim arguments above and Emens anticipates:

The method of setting the level of matching desired with respect to closeness, age of search, security and other constraints at col. 5, lines 35-45.

As per claim 19 same as claim arguments above and Emens anticipates:

Choosing by users in claim 1 the nature of community they wish to be invited into (e.g., communities that are public, private, narrow, broad, computer, telephonic, text or voice, limited by geography, etc.) at col.5, lines 50-60.

As per claim 20 same as claim arguments above and Emens anticipates:

providing in claim 1 a community with one or more of the following functions: telephonic, chat, bulletin board, links to related goods and services, other chats, other bulletin boards, Usenet groups, other groups and functions at col.10, lines 1-5, chat.

As per claim 24 same as claim arguments above and Emens anticipates:

The method of claim 1 as well as any other means of creating community including means to permit members of a community formed by the present invention to a) conduct joint searches and to post same for private or public viewing b) rate jointly and severally the content, consistency, depth and relevance of websites as well as other information valued by the community at col.10, lines 28-43.

**Claim Rejections - 35 USC § 103**

**22.** The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**23. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Emens et al (US 6,745,178) in view of Dowens et al (US 2002/0037074).**

As per claim 9 same as claim arguments above and Emens does not explicitly teach method of determining the similarity of searches in claim 1 that can be determined using a sounds-like program however Dowens does teach this limitation at parg. 24. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the cited references for efficient communications.

**24. Claims 11-12, 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Emens et al (US 6,745,178) in view of Herz (US 6,029,195).**

As per claim 11 same as claim arguments above and Emens does not explicitly teach The method of determining the similarity of searches in claim 1 that can be determined using a neural net program however Herz does teach this limitation at col. 26, lines 63-67 and col.94, lines 1-20. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the cited references for the purpose of routing at col. 94, line 18.

As per claim 12 same as claim arguments above and Emens does not explicitly teach

The method of teaching a neural net in claim 1 to learn from previous matches however Herz does teach this limitation at col. 26, lines 63-67 and col.94, lines 1-20. It been obvious to one of ordinary skill in the art at the time of the invention to combine the cited references for the purpose of routing at col. 94, line 18.

As per claim 21 same as claim arguments above and Emens does not explicitly teach

The method of using in claim 1 a telecommunications system consisting of voice communication over wired or wireless digital or analog phone systems for matching however Herz does teach this limitation at col.81, lines 15-25. It been obvious to one of ordinary skill in the art at the time of the invention to combine the cited references for the purpose of enabling to better communicate at col. 81, lines 20.

**25. Claims 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Emens et al (US 6,745,178) in view of Dietz (US 6,385,586).**

As per claim 22 same as claim arguments above and Emens does not explicitly teach

The method of permitting users to choose to take advantage of speech to text and text to speech technologies however Dietz does teach this limitation at fig.2. It been obvious to one of ordinary skill in the art at the time of the invention to combine the cited references for the purpose of enabling to efficiently communicate.



As per claim 23 same as claim arguments above and Emens does not explicitly teach  
The method of claim 1, including means to permit language translation so users can, for  
example, communicate within a single community in any language including Chinese,  
Russian, Spanish, Arabic, Japanese, Hebrew or English, and so forth however Dietz does  
teach this limitation at fig.2. It been obvious to one of ordinary skill in the art at the time of the  
invention to combine the cited references for the purpose of enabling to efficiently  
communicate in a foreign language at col.2, lines 48049.

### Conclusion

Any inquiry concerning this communication or earlier communications from the  
examiner should be directed to Susan Rayyan whose telephone number is (571) 272-4117.  
The examiner can normally be reached M-F: 8am - 4:30pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's  
supervisor, John Breene can be reached on (571) 272-4107 The fax phone numbers for the  
organization where this application or proceeding is assigned are (703) 872-9306 for Official  
communications, (703) 746-7238 for After Final communications and (703) 746-7240 for  
Status inquires and draft communications.

Any inquiry of a general nature or relating to the status of this application or proceeding  
should be directed to the receptionist whose telephone number is (571) 272-2100.

Susan Rayyan



March 17, 2005



Primary Examiner